

COMMENTS

The enclosed is responsive to the Examiner's Office Action mailed on December 29, 2004. At the time the Examiner mailed the Office Action claims 92-119, 131-141 and 161-168 were pending. By way of the present response the Applicant has: 1) amended claims 167 and 168. As such claims 92-119, 131-141 and 161-168 remain pending. The Applicant respectfully requests reconsideration of the present application and the allowance of claims 92-119, 131-141 and 161-168.

The Examiner has objected to claims 167 – 168 because "remote telephone interface" in each claim lacks antecedent basis. See, Examiner's Office Action, mailed 12/29/04, pgs. 2. In response, the Applicant has replaced the word "remote" with the word "second" and respectfully submits that the basis for the Examiner's objection has been overcome.

The Examiner continues to reject the Applicant's claims 92, 94, 100, 102, 108-112, 119, 131-135, 149, 141 and 161 under 35 USC 103 using the Chang reference as a basis for teaching or suggesting the overall claimed methodology combined with the Guy and Binkerd references as a basis for teaching or suggesting the specific manipulation of telephone interface signals. See, Examiner's Office Action, mailed 12/29/04, pgs. 2.

Section 2141 of the MPEP provides (emphasis added):

"[w]hen applying 35 USC 103, the following tenets of patent law *must* be adhered to:

(A) The claimed invention must be considered as a whole;

(B) The references must be considered as a whole and must suggest the desirability and thus the obviousness of making the combination;

(C) The references must be viewed without the use of impermissible hindsight vision afforded by the claimed invention; and

(D) Reasonable expectation of success is the standard by which obviousness is determined." MPEP 2141.

With respect to hindsight it is worth noting that "[i]t is impermissible to use the claimed invention as an instruction manual or 'template' to piece together the teachings of the prior art so that the claimed invention is rendered obvious . . . '[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.' " In re Fitch 972 F.2d 1260, 1266 (Fed. Cir. 1992).

The Applicant respectfully submits that the Examiner is combining references that do not suggest among themselves the desirability of their own combination.

As discussed in the Applicant's Office Action response mailed September 17, 2004, the Chang reference simply does not address the semantics of how a PBX on the caller side (e.g., PBX 4512 in the applicant's specification) is treated - at least with respect to call termination. The Applicant's specification describes a methodology whereby a caller side PBX is permitted to "think", while an unsuccessful call attempt is made to a remote location through a packet data

network, that it is in communication with a local telephone that (i) answers the caller's call ("off-hook") and (ii) initiates termination of the call ("on-hook").

With respect to call termination, the Chang reference only indicates that a voice message is played for the caller as a consequence of a "ring-no-answer" at the callee's end. See, Chang Col. 11, lines 10-23; Col. 14, lines 11-16; Col. 16, lines 22-35. Nothing is said in Chang as to whether the system taught by Chang or the caller is expected to initiate termination of the call in response to the voice message. In order for the Examiner to build a more complete rejection, the Examiner needs at least to find prior art that shows some kind of automated telephone system that initiates call termination to the caller upon a "ring-no-answer". This is the only type of "suggestion" that could possibly link the Chang reference with the Guy and Binkerd references.

Because the Examiner's rejection is based upon a suggestion that simply does not exist in the references cited by the Examiner, the Applicant respectfully submits that the Examiner's rejection is improper and that all of the Applicant's independent claims are allowable as a consequence.

Therefore, the Applicant respectfully submits that all claims are presently in allowable form and should be permitted to pass to allowance.


Applicants respectfully submit the present application is in condition for allowance. If the Examiner believes a telephone conference would expedite or assist in the allowance of the present application, the Examiner is invited to call Robert O'Rourke at (408) 720-8300.

Authorization is hereby given to charge our Deposit Account No. 02-2666 for any charges that may be due.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN

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